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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,989	07/09/2001	Kenneth S. Price	12748-0004	6871

7590 05/23/2005  
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EXAMINER

REAGAN, JAMES A

ART UNIT PAPER NUMBER

3621

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/900,989	Applicant(s) PRICE ET AL.	
	Examiner James A. Reagan	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 22-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Status of Claims

1. This action is in reply to the response filed on 29 March 2005.
2. Claims 49-54 have been added.
3. Claims 22-54 have been examined.

## RESPONSE TO ARGUMENTS

4. Applicant's arguments received on have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Tipton discloses a waste management system: "Therefore, it would be desirable to provide an information and compliance *database system* that provides the user with a wide variety of critical information including handling, storage, and emergency response

methods and guidelines for a cradle-to-grave management of hazardous chemicals and waste" (emphasis added; see at least column 2, lines 53-58). Applicant is also directed to column 39, line 53+ wherein Tipton discloses SQL searching and reports. The Structured Query Language (SQL) is a system for utilizing a database to search for and retrieve records that match search criteria (see at least column 40, line 58 to column 41, line 9). Sutcliffe also discloses using a database to search for matches based upon user-defined criteria (see at least column 1, line 64 to column 2, line 7). Clearly, one of ordinary skill in the art would not require a great deal of hindsight, if any at all, to suppose that a matching system applied to chemical waste management and a matching system used for dating purposes would find use in solving the problem of matching waste products with waste management services.

Applicant goes on to imply that the combination of Tipton and Sutcliffe does not disclose or suggest the combination of elements recited in independent claims 22, 39 or 43. Specifically, Applicant asserts that the examiner does not point out any disclosure or suggestion in Tipton or Sutcliffe of at least the following elements from independent claim 22:

- *a computer storage medium storing 'waste management data associated with a plurality of vendors having waste management capabilities and providing waste management services and entity profile data associated with a plurality of waste producing entities having waste processing requirements and producing waste components;*
- *first computer system configured to access the computer storage medium and stored waste management data and entity profile data, and further configured to associate a set of vendors from the plurality of vendors to provide waste management service for the waste producing entity;*

However, as shown above, both Tipton and Sutcliffe disclose database functionality and matching techniques. The Examiner respectfully points out that these limitations contain non-functional data. Since the application currently before the Examiner is a utility patent, the claims

must be directed to systems, methods, or articles of manufacture that have a clear utility. See MPEP 706.03(a). Over the years, numerous court decisions have analyzed the content of various claim language for meaningful, useful differences in structure or acts performed between the claims and the prior art. Some of these decisions have found that certain language adds little, if anything, to the claimed structure or acts and therefore do not serve as a limitation on the claims to distinguish over the prior art. Thus, the limitations on the claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *In re Gulack*, 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (bdPatApp&Int 1985) and *In re Lowry*, 32 USPQ2d 1031 (CAFC 1994), where language provided certain limitations because of specific relationships required by the claims. In the computer arts we frequently examine claims that are directed to systems, methods, and articles (computer program products) that process data. In these specific cases, nonfunctional descriptive material is material that cannot exhibit any functional interrelationship with the way in which computing processes are performed.

As a result, when analyzing claim language for its limited effect, the Examiner will perform two basic steps:

- i) Review the claimed as a whole to see whether or not any descriptive material is being recited; and
- ii) If a descriptive material is found, determine how this descriptive material is being used in the claim as a whole.

In this case, the claim language contains nonfunctional data in the form of data maintained on a database. This nonfunctional data is not processed by the computer, nor does it alter the process steps, except during the matching step, which has already been addressed.

Claims 39 and 43 recite similar steps and components, and the assertions set forth by the Applicant with regard to the Examiner's apparent deficiency rejecting claims 39 and 43 are responded to in kind.

Ergo, the Examiner has adequately addressed the three steps required by MPEP Section 2143.

With regard to claims 40-42, the common knowledge declared to be well-known in the art is hereby taken to be admitted prior art because the Applicant either failed to traverse the Examiner's assertion of Official Notice or failed to traverse the Examiner's assertion of Official Notice adequately. To adequately traverse the examiner's assertion of Official Notice, the Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice would be inadequate. Support for the Applicant's assertion of should be included.

#### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tipton et al. (US 6,097,995 A) in view of Sutcliffe et al. (US 6,052,122 A).

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 22-28, 39:**

Tipton discloses a waste management and disposal system, inflow and outflow of regulated chemical waste to a plurality of stations (see at least column 3, lines 1-33), utilization of computer networks and database systems (see at least Figures 5a and 5b), and report generation (see at least Figures 67-69 and associated text). Tipton does not specifically disclose a matching mechanism within the database structure. Sutcliffe, however, in at least column 2, lines 30-33 discloses a matching system wherein user are matched according to criteria described by the user by searching through user profiles contained within a database. It would have been obvious to combine the existing waste management systems as taught by Tipton and modify the teachings to include the functionality of database matching techniques as shown by Sutcliffe because the resultant system would solve the problem of efficiently and cost-effectively matching waste producer with waste manager, improving upon the existing matching system of Tipton by more closely matching according to pre-selected criteria.

**Claim 29:**

Tipton includes legislative and regulatory information (see at least column 2, lines 2-3).

**Claims 30, 31:**

Tipton discloses monitoring inflows and outflows (see at least column 3, lines 1-9), inherently disclosing a sensing device. Scheduling/rescheduling of waste removal is an obvious outcome and benefit of constant monitoring.

**Claims 32 and 33:**

Tipton discloses using computer network and database functionality as shown above. Tipton does not specifically disclose profile criteria. Sutcliffe, however, does, and therefore it would be obvious to one of ordinary skill in the art at the time of the invention to utilize the flexibility and efficiency of a database system to match waste producer with waste disposal vendors to efficiently dispose of waste products.

**Claims 34 and 35:**

Tipton discloses monitoring inflows and outflows (see at least column 3, lines 1-9), inherently disclosing a sensing device. Scheduling/rescheduling of waste removal is an obvious outcome and benefit of constant monitoring.

**Claim 36:**

Tipton's use of databases as disclosed above inherently discloses storage of waste processing data.



**Claims 37 and 38:**

Tipton discloses report generation as shown above. Generation of financial reports would be an obvious and necessary inclusion.

**Claims 40-42:**

The combination of Tipton/Sutcliffe as shown above discloses the waste management matching system as claimed by the Applicant. Tipton/Sutcliffe also disclose setting specific criteria for properly matching producer with vendor in order to efficiently manage and dispose of harmful waste products. Although this system inherently discloses evaluation of a vendor's capabilities, and the requirements of the waste producing facility, the combination does not specifically address the step of evaluating or reevaluating the vendors. However, it would have been obvious to one of ordinary skill in the waste disposal arts at the time of the invention to include in the profile matching step the set of criteria that apply to adequately matching processing requirements with disposal capabilities and updating these criteria necessary or required. In addition, practices which reduce waste products while increasing profitability by reducing cost are old and well-known factors in matching consumer with vendor, and the Examiner takes **Official Notice** of this long standing relationship. Reducing pollutants reduces cost and increases profits. In addition, Tipton discloses regulatory standards as shown above, inherently disclosing the necessity for constant evaluation and reevaluation of vendor capabilities.

**Claims 43-48:**

Claims 43-48 recite essentially the same limitations as claims 22-42, and are therefore rejected on the same grounds with the same rationale as shown above.

**Claims 49-54:**

The combination of Tipton/Sutcliffe as shown above discloses the waste management matching system as claimed by the Applicant. Tipton/Sutcliffe do not specifically disclose *the waste components include at least one of hazardous waste, industrial waste, refuse, recyclable plastics, and recyclable cardboard*. However, Examiner takes **Official Notice** that it is old and well known in the waste management that waste commonly consists of hazardous waste, industrial waste, refuse, recyclable plastics, and recyclable cardboard, among other things. For this reason, it would be obvious to one of ordinary skill in the waste management arts to conceive of hazardous waste, industrial waste, refuse, recyclable plastics, and recyclable cardboard.

**Conclusion**

7. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
8. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

**703.305.7687** [Official communications, After Final communications labeled "Box AF"]

**703.308.1396** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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JAR

16 May 2005

